

## **REMARKS/ARGUMENT**

This Amendment was prepared and filed in connection with the refiling of the application in the form of a Request for Continuing Examination (RCE) and in response to the Final Rejection issued October 13, 2005.

Consideration of the amendments to the claims is respectfully requested, inasmuch as the applicant has refiled the application as an RCE application.

Claims 11 and 13 were pending in this application. According to the October 13, 2005 Final Rejection, claims 11 and 13 were rejected. Applicants have amended claims 11 and 13 and added new claim 32. Accordingly, claims 11, 13, and 32 are under consideration. Applicants maintain that the amendments do not introduce any new matter.

Applicants respectfully request this amendment be entered as it raises no new issues, and will place the application in condition for allowance. However, if the Examiner is not persuaded that the application is now in condition for allowance, applicants respectfully request this amendment be entered to place the application in better condition for appeal.

### **Amendments to Claims 11 and 13 and New Claim 32**

To further protect applicants' invention, applicants have amended claim 11 to remove the limitation directed at the discrimination signal being "in relation to the number of pixels of said imaging device." The Examiner's attention is respectfully directed to the response to the Office Action of January 14, 2005, in which applicants amended claim 11 to include this now removed limitation. Accordingly, applicants submit that the Examiner has already substantially examined amended claim 11 and that amended claim 11 thereby does not raise new issues.

To further protect applicants' invention, applicants have also added new claim 32, which depends from claim 11. Claim 32 resembles previously canceled claim 12, which the Examiner has already examined. As such, claim 32 also does not raise new issues.

The Examiner indicated that the dependency of claim 13 is wrong since it depends from canceled claim 12. Applicants have amended claim 13 to depend from new claim 32.

### **Rejection of Claims 11 and 13**

The Examiner rejected previously presented claims 11 and 13 under 35 U.S.C. 102(e) as being anticipated by Hiyama et al., patent 5,379,757, January 10, 1995 (hereinafter Hiyama).

Amended claim 11 now recites an endoscopic imaging system, comprising,

an imaging device ...;

a digital signal converter for converting an image signal sent from said imaging device into a digital signal;

a signal processor for processing said digital signal sent from said digital signal converter;

a discriminating signal appending circuit for appending a discrimination signal to said digital signal processed by said signal processor;

a compression circuit for determining a level of compressibility according to said discrimination signal appended by said discriminating signal appending circuit, and for compressing said digital signal processed by said signal processor; and

a recording unit for recording said digital signal compressed by said compression circuit on a recording medium.

The Examiner's citation of Hiyama (Office Action, page 3, lines 8-10) appears to indicate his belief that Hiyama discloses (in Figure 1, Figures 19-28, and Figures 60-64) a "discriminating signal appending circuit" as recited by amended claim 11. Applicants respectfully submit that the systems shown in these Figures do not include a "discriminating signal appending circuit for appending a discrimination signal to said digital signal processed by said signal processor [and] a compression circuit for determining a level of compressibility according to said [appended] discrimination signal."

Rather, the system in Figure 1 of Hiyama includes an endoscope 2 and a signal processor 5 for processing signals from the endoscope. Processor 5 outputs the processed signals at end 32, where the signals are forwarded to an apparatus 6 that compresses and records the signals. Apparatus 6 includes A/D converters 34a-c and three compressing means 35a-c, each of which compresses the endoscope signals.

As disclosed by Hiyama, the system of Figure 1 uses the *endoscope type* to select one of the three compressed signals from the three compressing means to store to disc 37. In particular, a switch 36 connects the outputs of the three compressing means to disc 37. A discriminating means 38 within processor 5 generates a discriminating signal based on the type of endoscope 2. This discriminating signal is passed to switch 36 externally from the endoscope signals and configures the switch to connect one of the compressing means 35a-c to the disc.

Thus, contrary to claim 11 the system of Hiyama's Figure 1 does not include a "discriminating signal appending circuit for appending a discrimination signal to said digital signal processed by said signal processor." Accordingly, the system of Hiyama Figure 1 does not disclose the system recited by claim 11.

Turning to Figures 19-28 of Hiyama, this system includes an endoscope 201, an observing apparatus (i.e., signal processor) 203, and an image recording apparatus 205. As shown in Figures 19 and 21, processor 203 processes the endoscope signals and forwards the processed signals at end 217 to the image recording apparatus 205, which thereafter compresses and records the signals. In particular, within image recording apparatus 205, the endoscope signals pass through input part 231, A/D converters 232, and memory 233 and thereafter to compressing circuit 234, which compresses the endoscope signals and stores the signals on recording system 235. As shown in Figure 19, recording apparatus 205 also includes an image analyzing part 251 and a compressing rate switching circuit 252. As disclosed by Hiyama, image analyzing part 251 uses memory 233 to analyze the characteristics of the endoscope signals. The resulting analysis is thereafter forwarded to compressing rate switching circuit 252, which uses the analysis to configure compressing circuit 234 with an appropriate compression rate.

Thus, again contrary to claim 11, the system of Hiyama's Figures 19-28 does not include a "discriminating signal appending circuit for appending a discrimination signal to said digital signal processed by said signal processor." Rather, endoscope signals pass from processor 203 to the compressing circuit 234 without ever having a discriminating signal appended thereto. As described above, the level of compressibility of the Hiyama Figures 19-28 system is determined by an analysis of the characteristics of the endoscope signals and not on a discriminating signal

appended to the endoscope signals. Accordingly, the system of Hiyama Figures 19-28 does not disclose the system recited by claim 11.

As for the system of Hiyama Figures 60-64, this system is similar to that of Figures 19-28.

Accordingly, for the forgoing reasons, Hiyama does not anticipate claim 11, or claims 13 and 32, which depend therefrom.

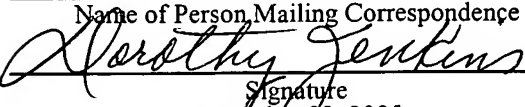
### **Conclusion**

Since Hiyama fails to teach or suggest applicants' invention as set forth in amended claims 11 and 13 and new claim 32, applicants respectfully request withdrawal of the Final Rejection, entry of this amendment, and favorable reconsideration and allowance of claims 11, 13, and 32.

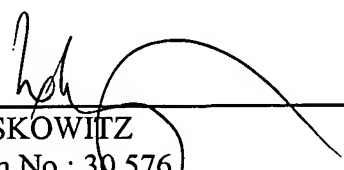
Applicants earnestly believe that this application is now in condition to be passed to issue, and such action is also respectfully requested.

Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

However, if the Examiner deems it would in any way facilitate the prosecution of this application, he is invited to telephone applicants' counsel at the number given below.

EXPRESS MAIL CERTIFICATE  
I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail to Addressee (mail label #EV606199475US) in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 29, 2005  
DOROTHY JENKINS  
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Name of Person Mailing Correspondence  
  
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December 29, 2005  
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Date of Signature

Respectfully submitted,

  
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